

REMARKS

In the Office Action dated August 15, 2006, claims 1-12, 14-16, and 18-22 were presented for examination. Claims 1-2 and 4-9 were rejected under 35 U.S.C. §102(e) as being anticipated by *Pickett et al.*, U.S. Patent No. 6,498,791. Claims 12, 15, 16, 18, and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Pickett et al.*, U.S. Patent No. 6,498,791, in view of the rejection of claim 1. Claims 3, 11, 21, and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Pickett et al.*, U.S. Patent No. 6,498,791, in view of *Frye*, U.S. Patent Publication No. 2003/0097553. Claims 10, 14, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Pickett et al.*, U.S. Patent No. 6,498,791 in view of *Zaudtke et al.*, U.S. Patent No. 6,654,816.

The following remarks are provided in support of the pending claims and responsive to the Office Action of August 15, 2006 for the pending application.

I. Rejection of Claims 1-2 and 4-9

In the Office Action dated August 15, 2006, the Examiner assigned to the application rejected claims 1-2 and 4-9 under 35 U.S.C. §102(e) as being anticipated by *Pickett et al.* '791.

The *Pickett et al.* '791 patent pertains to a method of deploying a communication system in a headless manner. As noted by Applicant in response to the First and Second Office Actions, Applicant's invention pertains to a service processor that provides support and maintenance of the computer system and the ability of the service processor to receive and transmit communications in a headless manner. The '791 patent does not provide a service processor that provides support and maintenance of a computer system. The '791 patent provides a switch/multiplexer to map data traffic between a buffer/framer and a bus. See Col. 3, lines 10-12. With respect to independent claims 1 and 7, Applicant is not claiming a switch or a multiplexer that routes data traffic. Rather, Applicant is claiming a service processor that is formatted for headless communication and that provides support and maintenance of the computer system. In theory a switch / multiplexer may be used to route commands that emanate

from a service processor. However, a switch / multiplexer is not a service processor in that it does not provide actual support and maintenance of the computer system as claimed by Applicant. There is no express teaching in the '791 for a service processor in the manner claimed by Applicant. As for whether the '791 patent inherently teaches a service processor, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."¹ The basis and/or technical reasoning has not been provided by the Examiner. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' "² It is clear in the law that to support an inherent position, the Examiner must provide facts or reasoning to show that the switch/multiplexer is equivalent to the service processor as claimed by Applicant or that the switch/multiplexer of the '791 patent routes data received from a service processor is necessarily present in the '791 patent. Accordingly, Applicant respectfully requests that the Examiner provide such facts or reasoning in the next communication to maintain this rejection.

Dependent claims 2 and 4-6 depending upon independent claim 1, and dependent claims 8 and 9 depending upon independent claim 7 also include the service processor as an element. Therefore, the Examiner's rejection of these claims under 35 U.S.C. §102(e) should not be upheld. A dependent claim, because it depends from an independent claim is a further limitation of the independent claim.³ If a limitation is not found in an independent claim, then it is not found in the dependent claims either. In the present case, the service processor is incorporated by reference into each dependent claim of the application. The analysis above shows that the *Pickett*

¹ MPEP §2112. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

² *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

³ 37 C.F.R. 1.75

et al. '791 does not anticipate the service processor of Applicant.

Accordingly, Applicant respectfully requests removal of the rejection and direct allowance of claims 1, 2, and 4-9.

II. Rejection of Claims 12, 15, 16, 18, and 19

In the Office Action dated August 15, 2006, the Examiner assigned to the application rejected claims 12, 15, 16, 18, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Pickett et al.* '791 in view of the rejection of claim 1.

Applicant's remarks to *Pickett et al.* '791 made above are hereby incorporated by reference.

Independent claims 12 and 16 include limitations pertaining to a multiplexer and a service processor as two separate elements. The multiplexer is an instrument for routing communication and the service processor is an instrument for provision of management commands. These are two separate and distinct elements of the claims. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."⁴ As noted above, *Pickett et al.* '791 does not expressly or inherently teach a service processor that provides management comments to at least two partitions in a computer system. At most, it has been shown by the Examiner that the '791 patent includes a switch / multiplexer to route commands; which Applicant is claiming as an element in communication with the service processor. "In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents."⁵ Management commands do not emanate from the switch /

⁴ MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁵ MPEP §2144.06, citing *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

multiplexer of the '791 patent. Rather, the multiplexer of the '791 patent, as well as the multiplexer of Applicant, is merely a conduit for ensuring that commands are appropriately relayed to instruments in the system.

It is well settled that each statement of obviousness must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusionary statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to equate the functionality of a multiplexer with that of a service processor in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to substitute the service processor of Applicant for the multiplexer of *Pickett et al.* '791 - especially since independent claims 12 and 16 distinctly claim both of these elements as separate elements in the claims. It is respectfully suggested that this rejection which does not contain the teachings of the claim elements is without merit and must be withdrawn.

Claim 15 depending upon independent claim 12, and claims 18 and 19 depending upon independent claim 16 also include the service processor as an element. Therefore, the Examiner's rejection of these claims under 35 U.S.C. §103(a) should not be upheld. A dependent claim, because it depends from an independent claim is a further limitation of the independent claim.⁶ If a limitation is not found in an independent claim, then it is not found in the dependent claims either. In the present case, the service processor is incorporated by reference into each dependent claim of the application. The analysis above shows that the *Pickett et al.* '791 does not anticipate the service processor of Applicant.

Accordingly, Applicant respectfully contends that the obviousness rejection of *Pickett et al.* '791 does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and

⁶ 37 C.F.R. 1.75

respectfully requests removal of the rejection of claims 12, 15, 16, 18, and 19 under 35 U.S.C. §103(a).

III. Rejection of Claims 3, 11, 21, and 22

In the Office Action dated August 15, 2006, the Examiner assigned to the application rejected claims 3, 11, 21, and 22 under 35 U.S.C. §103(a) as being unpatentable over *Pickett et al.* '791 in view *Frye*, U.S. Patent Publication No. 2003/0097553.

Applicant's remarks to *Pickett et al.* '791 made above are hereby incorporated by reference.

Frye '553 pertains to a computer system and a method for booting one or more servers in the system with a pre-boot command. Independent claim 1 includes a limitation of a service processor, and independent claims 12 and 16 include limitations pertaining to a multiplexer and a service processor as two separate elements. The multiplexer is an instrument for routing communication and the service processor is an instrument for provision of management commands. These are two separate and distinct elements of the claims. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."⁷ As noted above, it is Applicant's position that *Pickett et al.* '791 does not expressly or inherently teach a service processor that provides management commands to at least two partitions in a computer system.

It is accepted that for a rejection under 35 U.S.C. §103(a) to stand, there must be a suggestion or motivation in the references themselves to modify the reference or combine the teachings.⁸ "The teaching or suggestion to make the claimed combination and the reasonable

⁷ MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁸ MPEP §2143

expectations of success must both be found in the prior art, not in applicant's disclosure."⁹ As noted by the Examiner, *Pickett et al.* '791 "does not explicitly teach pre-boot mode of operation." Office Action dated August 15, 2006, page 6, ¶1. *Frye* '55 "teaches pre-boot mode of operation." *Id.*, page 5, ¶2. However, it is Applicant's position that there is no motivation in the prior art references for combining *Pickett et al.* '791 and *Frye* '553. Rather, the motivation for such a combination stems from the language in Applicant's claims. Clearly, *Pickett et al.* '791 is silent about a pre-boot mode of operation. There is no teaching or suggestion in *Pickett et al.* '791 to modify their invention to support the pre-boot mode of operation, and there is no support in the prior art to modify the combination of *Pickett et al.* '791 and *Frye* '553 to employ all three of these modes of operation. The only support for the alleged combination stems from Applicant.

Furthermore, neither *Pickett et al.* '791 or *Frye* '553 teach a service processor in a computing environment as claimed by Applicant. It is the management commands of Applicant's service processor that support the in-band, out-of-band, and pre-boot modes of operation. The suggested combination of *Pickett et al.* '791 with *Frye* '553 would require a substantial reconstruction and redesign of the computer implemented management commands not envisioned or contemplated by *Pickett et al.* '791. Accordingly, it is Applicant's position that there is no motivation present in *Pickett et al.* '791 to be modified in the manner as claimed by Applicant.

It is clear that the Examiner is taking the elements of Applicant's pending claims and combining them in an improper manner. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Yet that is the very process that the Examiner has attempted to undertake. Most patents may be considered combination patents in which different elements are combined from prior art to achieve a new

⁹MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant's pending claims. There is no motivation in the prior art to combine the references. Accordingly, Applicant respectfully contends that the combination of *Pickett et al.* '791, and *Frye* '553 does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests removal of the rejection of claims 3, 11, 21, and 22 under 35 U.S.C. §103(a).

IV. Rejection of claims 10, 14, and 20

In the Office Action dated August 15, 2006, the Examiner assigned to the application rejected claims 10, 14, and 20 under 35 U.S.C. §103(a) as being unpatentable over *Pickett et al.* '791 in view of *Zaudtke et al.*, U.S. Patent No. 6,654,816.

Applicant's remarks to *Pickett et al.* '791 made above are hereby incorporated by reference.

Zaudtke et al. '816 is a patent pertaining to a communication interface of a computer system. The '816 patent does not teach or suggest use of a service processor in the interface or computer system. Dependent claims 10 and 14 include the limitations of a multiplexer, a service processor, and a UART communication channel. A multiplexer and a service processor are two separate and distinct elements. A multiplexer is an instrument for routing communication and a service processor is an instrument for provision of management commands. The multiplexer of *Pickett et al.* '791 does not support a UART communication channel. In fact, in the entire 121 pages of the '791 patent there is no express or implied teaching of a UART communication channel. Although the '816 patent teaches a UART communication channel, it does not teach or suggest use of a service processor. In fact, neither the '791 patent nor the '816 patent teach or suggest use of a service processor. "To establish prima facie obviousness of a claimed invention,

all the claim limitations must be taught or suggested by the prior art.”¹⁰ As noted above, it is Applicant’s position that *Pickett et al.* ‘791 does not expressly or inherently teach a service processor that provides management commands to at least two partitions in a computer system.

It is accepted that for a rejection under 35 U.S.C. § 103(a) to stand, there must be a suggestion or motivation in the references themselves to modify the reference or combine the teachings.¹¹ “The teaching or suggestion to make the claimed combination and the reasonable expectations of success must both be found in the prior art, not in applicant’s disclosure.”¹² As noted by the Examiner, *Pickett et al.* ‘791 “does not explicitly teach . . . said channel of said service processor are UART communication channels formatted for headless communication in compliance with headless firmware.” Office Action dated August 15, 2006, page 7, ¶4. *Zaudtke* ‘816 teaches a headless computer that implements UART ports. Id., page 7, ¶5. However, it is Applicant’s position that there is no motivation in the prior art references for combining *Pickett et al.* ‘791 and *Zaudtke* ‘816. Rather, the motivation for such a combination stems from the language in Applicant’s claims. Clearly, *Pickett et al.* ‘791 is silent about a UART communication channel. There is no teaching or suggestion in *Pickett et al.* ‘791 to modify their invention to support the UART communication channel. The only support for the alleged combination stems from Applicant.

It is clear that the Examiner is taking the elements of Applicant’s pending claims and combining them in an improper manner. “It is impermissible to use the claimed invention as an instructions manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992), citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991). Yet that is the very process that the Examiner has attempted to undertake, especially with the plurality of patents being used for the combination. Most patents may be considered combination patents in which

¹⁰ MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

¹¹ MPEP §2143

¹² MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

different elements are combined from prior art to achieve a new and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant's pending claims. There is no motivation in the prior art to combine the references. Accordingly, Applicant respectfully contends that the combination of *Pickett et al.* '791, and *Zaudtke* '816 does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests removal of the rejection of claims 10, 14, and 20 under 35 U.S.C. §103(a).

V. Conclusion

There is no teaching individually in *Pickett et al.* '791, *Frye* '553, and/or *Zaudtke* '816 for a computing environment that individually supports headless communication with a service processor, as claimed by Applicant. Nor is there a motivation to combine these multiple references to teach the elements in the dependent claims, as the only basis for such a motivation stems from Applicant.

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusionary statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before us lacks any valid reasons to combine the references in the manner done so by the Examiner and contains unsupported reasoning suggested by the Examiner. If the Examiner intends to maintain the obviousness rejections, Applicant respectfully requests that the Examiner enter factual evidence into the record to support their position. It is respectfully suggested that these obviousness rejections which contain neither teachings nor motivation to combine the references is without merit and must be withdrawn. Even the primary reference, *Pickett et al.* '791, does not teach or suggest the service processor of Applicant's claims. A service processor is not a multiplexer. Accordingly, Applicant respectfully request that the Examiner remove the

rejection of claims 1-12, 14-16, and 18-20.

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of the application, the Examiner is hereby invited to telephone the undersigned at the number provided.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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